

REMARKS

With (i) the addition of the previously canceled claim 43 as new claim 52, (ii) the addition of the previously allowed claims 11-17, 20-29, 32-34, 36, 41, 42, 44 and 47 as new claims 53-78, (iii) the addition of the previously objected to claim 30 (objected to as dependent on a rejected base claim but being allowable if made independent of the rejected base claim 1) as new claim 79, (iv) the addition of the previously canceled claims 48-51 as new claims 80-83, and (v) cancellation of claims 45 and 46, claims 1-3, 5-10, 18, 19, 31, 35, 37-40 and 52-83 are pending.

The previously allowed claims 11-17, 20-29, 32-34, 36, 41, 42, 44 and 47 were canceled in the Amendment filed on May 29, 2007. However, these previously canceled allowed claims are not added as new claims 53-78 in order to reduce the number of continuation application to be filed in light of the new PTO rules on the limitation of the number of continuation applications, wherein the new PTO rules may become effective in the future pending the outcome of legal challenges at the moment.

The previously objected to claim 30 is now presented as new claim 79, which is made independent of the rejected base claim 1.

Claims 38 and 40 are amended to overcome the objections that claims 38 and 40 improperly depend on two claims. The amendments to claims 38 and 40 would not narrow the scope of claims 38 and 40.

An editorial amendment to claim 1 is made using the wordings from page 7, lines 10-12, of the specification. No narrowing of claim 1 will be caused by this amendment.

Claim Objections

Claim 40 was objected to for allegedly improperly dependent on claim 39 and claim 8. Similarly, claim 38 was objected to for allegedly improperly dependent on claim 37 and claim 1. Claims 38 and 40 have been amended as shown above rendering the objections moot. Withdrawal of the objection is requested.

Claim Rejection -- 35 U.S.C. 112, First Paragraph

Applicants respectfully traverse the indefiniteness rejection of claim 5. Without acquiescence with the rejection, claim 5 has been made independent of claim 1. Withdrawal of the rejection is requested.

Claim Rejections -- 35 U.S.C. 112, First Paragraph

Applicants respectfully traverse the rejections of claims 45 and 46 for failing to comply with the written description requirement. The cancellation of claims 45 and 46 has rendered the rejection moot.

Claim Rejections -- 35 U.S.C. §102

(A) Applicants respectfully traverse the anticipatory rejection of claim 35 over Harnden 1990 (*Nucleosides & Nucleotides* (1990) 9:499-513). Applicants contend that Harnden 1989 discloses a process of preparing famciclovir requiring two steps of solvent removal, which would remove all methanol for all practical purposes. The Office Action wants to remind applicants that Example 7 disclosed in page 13, lines 1-8, of the specification. The Office Action alleges that methanol was retained in Example 7 even though the wet famciclovir Form III crystals were dried at 65°C under vacuum for two hours to obtain Form I. However, applicants would like to point out that there is no evidence that the Form I obtained in Example 7 contain methanol. If the Examiner was referring to the methanol associated with Form III, applicants note that Form III is a methanol solvate so the methanol is trapped in the crystalline lattice of Form III and not free methanol. In contrast, the methanol in the "methanol/water mixture" recited in claim 35 is not methanol molecules trapped in crystals of an organic compound such as famciclovir.

Withdrawal of the anticipatory rejection is requested.

(B) Applicants also respectfully traverse the anticipatory rejections of claims 1-3, 5-10, 18, 19, 31, 37-40 and 43 over Harnden 1989 (*J. Med. Chem.* (1989) 32: 1738-1743); US 5,017,701; US 5,066,805; US 5,138,057; US 6,846,927; US 6,342,603; Freer (*Tetrahedron* (2000) 56:4589-4595); Geen (*Tetrahedron*, Vol. 46, pp. 6903-6914, 1990), US 6,437,125 and WO 2000/06573.

The Examiner took a position that the rejected claims were merely directed to an old product, i.e., a famciclovir crystalline form, having new property, citing MPEP 2112. In contrast, applicants explain that the "new property" such as the XRD pattern referred to by the Examiner is not merely a new property of an old product. Contrary to the position of the Examiner, the new XRD patterns recited in the rejected claims is a property of new products, i.e., new crystalline forms of famciclovir.

The Examiner also took a position that the rejection "is not an ordinary inherency situation." Applicants respectfully disagree. Applicants contend that the anticipatory rejection was made based on the inherency principle because none of the cited prior art references disclose the claimed crystalline forms of famciclovir having the XRD patterns recited in the claims. For a claim to be rejected as anticipated by a prior art reference, one skilled in the art must recognize that the disclosure of the reference necessarily leads to the claimed product. However, in the

prior art references cited by the Examiner, applicants contend that one skilled in the art would not recognize that the products disclosed in the references would necessarily be the claimed products. There is no evidence that the specific crystalline form claimed would necessarily be formed according to the processes disclosed in the prior art in order to allow proper anticipatory rejections of the claims under the inherency principle.

Withdrawal of all the anticipatory rejections is requested. Even though the applicants disagree with the anticipatory rejections, to advance prosecution the applicants would be willing to consider experimental showing if the claims are otherwise indicated to be allowable.

Conclusion

With the above reasoning, applicants submit that the application is in a condition for allowance. The Examiner is urged to contact the undersigned by phone if there remains any minor issues.

In the event that the filing of this paper is deemed not timely, applicants petition for an appropriate extension of time. The petition fee and any other fees that may be required in relation to this paper can be charged to Deposit Account No. 11-0600 referencing Attorney Docket No. 01662/60903.

Respectfully submitted,

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